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10/817,625

04/01/2004

Joseph R. Hedrick

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06/18/2010

Weaver Austin Villeneuve & Sampson LLP - IGT

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EXAMINER

LAYNO, BENJAMIN

ART UNIT

PAPER NUMBER

3711

NOTIFICATION DATE

DELIVERY MODE

06/18/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/817,625 | <b>Applicant(s)</b><br>HEDRICK ET AL. |  |
|                              | <b>Examiner</b><br>Benjamin H. Layno | <b>Art Unit</b><br>3711               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-38, 49, 52-58 and 60-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 10-25 and 27 is/are allowed.
- 6) ☒ Claim(s) 26, 28-38, 49, 52-58 and 60-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/01/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. After further review of the amendment filed 03/08/06, the Examiner has decided to withdraw the allowability of claims 26, 28-38, 49, 52-58 and 60-67.

#### *Reissue Applications*

#### *Rejection, 35 U.S.C. 251*

1. Claims 26, 28-38, 49, 52-58, and 60-67 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The reissue application was filed on 04/01/04 which is within two years of the patent grant date of 04/09/02. However, there was no preliminary amendment with broadened claims or a statement establishing an intent to broaden. Then amendment filed 03/08/06 introduced amended claim 26 and new claims 28-38, 49, 52-58 and 60-67 which are broader than the claims in the patent. This is clearly outside the two year statutory period of 04/09/04 of the patent grant date. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. See MPEP 1412.03.

In the original application (Appl. No. 09/615,968) an amendment was made narrowing the claims to overcome the prior art. The amendment included inserting the recitation **"a player tracking device mounted on said chassis, said player tracking device comprising, a display separate from said main display and said secondary**

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**display**", in independent claims 1, 23, 24, 25, 26 and 27 of the patent (Pat. No. 6,368,216). All these patented claims recite a gaming machine having "a main display", a secondary display", and "a player tracking device" that is separate from the main display and the secondary display".

In regard to claim 26 of the present reissue application (Appl. No. 10/817,625), the amendment filed on 03/08/06, amended claim 26 by **omitting** the **limitation "a display, separate from said main display and said secondary display"** making claim 26 broader in scope than the original claim 26 of the patent (Pat. No. 6,368,216). This limitation was replaced by different narrowing limitations of "operable to display video content comprising pixilated video frame data related to a least a secondary bonus game", "a graphics controller operable to provide the video content to the secondary display fast enough to allow animated objects to appear to move continuously on the secondary display", and "the video content comprising pixilated video frame data related to the player tracking information" which are not related to the omitted limitation. The omitted limitation relates to subject matter previously surrendered by Applicant, **impermissible recapture of surrendered subject matter exists**. See *Pannu*, 258 F.3d at 1372, 59 USP2ed at 1601. Once a patent is obtained by adding a limitation to the claims to define over the art, that limitation, or a limitation related to that limitation, must remain in the claims.

Concerning new claim 49 of the present reissue application (Appl. No. 10/817,625), new claim 49 recites similar limitations as independent claims 1, 23, 24, 25, 26 and 27 of the patent (Pat. No. 6,368,216) including "a chassis", "a gaming

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machine controller", "a main display" and "a secondary display". However, claim 49 **omits** the limitation of "**a player tracking device mounted on said chassis, said player tracking device comprising, a display, separate from said main display and said secondary display**", making claim 49 broader in scope than the original claims of the patent (Pat. No. 6,368,216). Included in claim 49 are the narrowing limitations "a top box portion wherein said top box portion is detachable from the gaming machine and is located above the main display portion of the gaming machine" and "operable to display video content comprising pixilated video frame data". These narrowing limitations do not relate to the omitted limitation. The omitted limitation relates to subject matter previously surrendered by Applicant, **impermissible recapture of surrendered subject matter exists**. See *Pannu* above. Once a patent is obtained by adding a limitation to the claims to define over the art, that limitation, or a limitation related to that limitation, must remain in the claims.

In regard to new claim 63 in the present reissue application (Appl. No. 10/817,625) recites similar limitations as independent claims 1, 23, 24, 25, 26 and 27 of the patent (Pat. No. 6,368,216) including "a chassis", "a gaming machine controller", "a main display" and "a secondary display". However claim 63 **omits** the limitation of "**a player tracking device mounted on said chassis, said player tracking device comprising, a display, separate from said main display and said secondary display**", making claim 63 broader in scope than the original claims of the patent (Pat. No. 6,368,216). Included in claim 63 is the narrowing limitation "a top box portion wherein said top box portion is detachable from the gaming machine and is located

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above the main display portion of the gaming machine". This narrowing limitation does not relate to the omitted limitation. The omitted limitation relates to subject matter previously surrendered by Applicant, **impermissible recapture of surrendered subject matter exists**. See *Pannu* above. Once a patent is obtained by adding a limitation to the claims to define over the art, that limitation, or a limitation related to that limitation, must remain in the claims.

***Rejection, 35 U.S.C. 251, New Matter***

1. Claims 26, 28-38, 49, 52-58, and 60-62 are rejected under 35 USC 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

In amended claim 26, line 14-22 of the reissue application recites "a player tracking device mounted on said chassis, said player tracking device comprising..... the gaming information is designed or configured to cause the player tracking information and the **video content comprising pixilated video frame data related to the playing tracking information** to be displayed on at least one of the main display and the secondary display". The 216' patent discloses a gaming machine having a main display 220 for presenting a primary game play and outcome information, a secondary display 219, which is a video display, for displaying secondary information, and a player tracking device 313, 518 associated with a player tracking device for displaying alpha-numeric messages associated with the player tracking function, col. 7, lines 11-13 and col. 9, lines 23-33. The 216' patent describes that alpha-numeric content from the

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player tracking display 518 may be provided on the main display 220 or secondary display 219, col. 9, lines 33-35. **However, the 216' patent fails to disclose or suggest that the player tracking information has video content.**

In new claim 49, lines 10-13 of the reissue application recites "a secondary display separate from the main display which is operable to display video content comprising pixilated video frame data wherein the gaming machine is operable to cause **video content including player tracking information** to be displayed on the secondary display". **The 216' patent fails to disclose or suggest that the player tracking information has video content.**

Thus, claims 26 and 49 introduce new matter into the 216' patent for which reissue is sought.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 26, 28-38, 49, 52-58, and 60-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was **not** described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See the new matter rejection above.

***Response to Arguments***

4. Applicant's arguments filed 03/08/06 have been fully considered but they are not persuasive. In the Applicant's remarks under the heading "Support of New Claims", the Applicant list citations (column, lines) in the specification **only refers to video content as it relates to the secondary display 219**. For example the Applicant recites "one or more interfaces designed or configured to input player tracking information into the gaming machine", "operable to provide the video content to the secondary display fast enough to allow animated objects to appear to move continuously on the secondary display", "It should be noted that insertion of player tracking card may alert the machine that a particular customer is playing. In response, the machine may display particular images on LCD 219" and "display 518... which displays information relevant to player tracking...Alternatively, the content displayed on display 518 may be provided on main display 220 or secondary display 219". **None of these citations suggest that the player tracking information includes or is related to video content.**

***Allowable Subject Matter***

2. Claims 1-8, 10-25 and 27 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571)272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin H. Layno/  
Primary Examiner, Art Unit 3711

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